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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,058	02/02/2004	Gregory Lee Burns	BURNS-001	1519
7590 ANDREW D. GATHY P.O. BOX 351 EAST LYME, CT 06333		06/01/2007	EXAMINER RODRIGUEZ, RUTH C	
			ART UNIT 3677	PAPER NUMBER
			MAIL DATE 06/01/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/771,058

Applicant(s)

BURNS, GREGORY LEE

Examiner

Ruth C. Rodriguez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-20 is/are allowed.
- 6) ☒ Claim(s) 1-7,9-15 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The indicated allowability of claim 12 (that included indicated allowable subject matter of claim 16) is withdrawn. The Examiner regrets any inconvenience experienced by the Applicant due to the prior indication of allowability of this claim, however, upon detailed study of the Koch et al. it has been determined that the reference meets this claims. Although figures 9 and 10 misleadingly seem to show that the cross section is circular, this circular cross section is only provided at flanges provided at the end of the inserts however the cross section of the body of the insert that lies within the clamp does meet this limitation as shown in the dotted lines of these figures and in figures 2 and 6-8.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 November 2006 has been entered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-7, 9-11 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 recites "at least one clamp insert having an eccentric form insertable in each of the said first motorcycle fork clamp and said second motorcycle fork clamp, said clamp insert configured to shift said offset of a motorcycle, wherein said at least one clamp insert comprises a ball clamp insert having a ball clamp body forming a ball cavity supporting a ball insert". However, these limitations lack enablement because if each of the at least one clamp inserts has an eccentric form and is insertable into each of the first motorcycle fork clamp and the second motorcycle fork clamp and therefore the ball clamp insert fails to have a motorcycle fork clamp that will accept the ball clamp insert. The claim needs to recite that clamp further comprises an additional body having a third fork clamp and a fourth fork clamp and that the ball clamp body is inserted into one of the third fork clamp or the fourth fork clamp. The same rejection will apply to claim 17.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 10-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Koch et al. (US 3,342,507).

A motorcycle clamp comprises a clamp body (10), an offset and a clamp insert (23). The clamp body forms a first motorcycle fork clamp (12) and a second motorcycle fork clamp (12), a motorcycle center steering pivot formed in the clamp body between the first fork clamp and the second fork clamp (Fig. 1). The motorcycle center steering pivot defines a steering centerline (Fig. 1). The first and second motorcycle fork clamps define a fork centerline (Fig. 1). The offset is formed between the steering centerline and the fork centerline (Fig. 1). The clamp insert includes an insert body defining an insert wall defining an inside diameter and an insert outside diameter (Figs. 6- 9). The clamp insert outside diameter is configured to be insertable in each of the first motorcycle fork clamp and the second motorcycle fork clamp and configured to shift the offset of a motorcycle front wheel (Figs. 1 and 6-8). The insert outside diameter includes an oval shape and the insert body is reversible 180 degrees (when taking the middle of the inset shown in Figs 1 and 5-10). A first offset and a second offset are configurable from the reversible insert body (Figs. 1 and 5-10).

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The insert wall comprises a variable thickness (Figs. 6 - 9). The variable thickness forms an eccentric insert center relative to the insert outside diameter (Figs. 6-9).

The clamp insert includes a reversible feature (Figs. 6-9). The reversible feature is configured to create a first shift in the offset and a second shift in the offset (Figs. 6-9).

The inside diameter is configured to mount a fork (Figs. 1 and 6-9).

Allowable Subject Matter

7. Claims 18-20 are allowed.
8. Claim 1 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action.
9. Claims 2-7, 9-11 and 17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Applicant's arguments filed 26 March 2007 have been fully considered but they are not persuasive.
11. The Applicant argues that claim 1 is allowable over Koch based on the indication of allowability provided by the Examiner. However upon detailed study of this claim, it

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was determined that the claim lacks enablement because if each of the first motorcycle clamps has an eccentric clamp insert there is no possible way to provide an additional ball clamp body especially since the disclosure does not support having a ball clamp body that is eccentric. The Examiner suggested adding the secondary triple clamp being disclosed in the specification in order to provide a third motorcycle clamp or a fourth motorcycle clamp that receives the ball clamp body in accordance with the disclosure.

12. The argument presented for claim 12 is that the claim is allowable based on the prior indication of allowability. However as indicated above, Koch does meet this claim and the prior indication of allowability is withdrawn.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kock et al. (US 3,342,507) and Kao (US 5,404,769) are cited to show state of the art with respect to the use of eccentric inserts in automobile parts. Robinson (US 3,866,946), Scheibe et al. (US 5,938,225), Callaluca et al. (US 5,967,538), Nakagawa et al. (US 6,783,158 B2) and German Patent Document DE 39 33 058 A1 are cited to show state of the art with respect to triple clamps having some of the features being claimed by the current application for changing the offset.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C. Rodriguez whose telephone number is (571)

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272-7070. The examiner can normally be reached on M-F 07:15 - 15:45. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (571) 272-7075.


Submissions of your responses by facsimile transmission are encouraged. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-6640.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ruth C. Rodriguez
Patent Examiner
Art Unit 3677

rcr
May 29, 2007


JJ Swann
Supervisory Patent Examiner
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